REMARKS

Applicants wish to thank the Examiner for reviewing the present patent application. Applicants respectfully request that the final rejection be withdrawn. The final rejection is premature since the Examiner has raised new prior art and not afforded Applicant the opportunity to respond to the same under conditions that are not final. Again, the final rejection should be withdrawn and the present Office Action should be made non-final.

I. Rejection Under 35 USC §112, Second Paragraph

The Examiner has rejected claim 6 under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claim 6 wherein the amended language may be found on page 4 (among other places) of the specification as originally filed. Therefore, no new matter has been added and Applicant respectfully requests that the rejection made under 35 USC §112, second paragraph be withdrawn and rendered moot.

II. Rejection Under 35 USC §102(b)

The Examiner has rejected claims 1, 3-6 and 9 under 35 USC §102(b) as being anticipated by Schellgell et al., U.S. Patent No. 3,641,918 (hereinafter '918). In the rejection, the Examiner mentions, in summary, that Schellgell discloses a method of preparing a beverage wherein a coffee extract which has been concentrated is heated to a temperature of 110°F and mixed with heated water at 195°F to produce a beverage on demand. Moreover, the Examiner mentions that the instant claims call for the beverage extract to be heated within a beverage brewing machine, but the Examiner believes that this does not provide a patentable distinction. In view of the above, the Examiner believes that the novelty rejection is appropriate.

Notwithstanding the Examiner's apparent position to the contrary, it is the Applicant's position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

Independent claim 1, as amended, is directed to a method for making a beverage comprising the steps of heating beverage extract within a beverage brewing machine to a temperature from about 75°C to about 90°C to produce a heated beverage extract; and mixing the heated beverage extract with a solvent to produce a beverage on demand.

The invention of claim 1 is further defined by the dependent claims which claim, among other things, that the beverage extract is a tea extract.

In contrast, the '918 reference merely discloses an automatic coffee dispenser for making coffee whereby concentrate is normally at a temperature of approximately 40°F when it is refrigerated and raised to a temperature of approximately 110°F. The '918 reference discloses a method which heats an extract to 57°F lower than the extract in the now claimed invention. In view of this, it is clear that all the limitations set forth in the presently claimed invention are not set forth in the '918 reference, and therefore, the novelty rejection should be withdrawn and rendered moot.

III. Rejection Under 35 USC §103

The Examiner has rejected claims 2, 7 and 8 under 35 USC §103 as being unpatentably over Schellgell et al., U.S. Patent No. 3,641,918 (hereinafter '918).

In the rejection, the Examiner mentions, in summary, that the claims call for the extract to be a tea extract and that the '918 reference is directed to coffee. Nonetheless, the Examiner believes that in the absence of unexpected results it would have been obvious to one of

ordinary skill in the art at the time the invention was made to utilize the '918 reference teachings to incorporate tea in lieu of coffee as the desirable beverage. Moreover, the Examiner believes that the amount of extract used would be obvious. In view of the above, the Examiner believes that the obviousness rejection is warranted.

Notwithstanding the Examiner's apparent position to the contrary, it is the Applicant's position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

As already made of record, the present invention is directed to a method for making a beverage comprising the steps of heating beverage extract within a beverage brewing machine to a temperature from about 75°C to about 90°C to produce a heated beverage extract; and mixing the heated beverage extract with a solvent to produce a beverage on demand.

The invention of claim 1 is further defined by the dependent claims which claim, among other things, that the extract is a tea extract, and that the beverage comprises less than about 45% by weight heated solvent and that the beverage is translucent and does not comprise visible particles of extract. In contrast, the '918 reference is directed to coffee which is not translucent. Moreover, nothing in the '918 reference would suggest that a tea extract could be heated and combined with a heated solvent to produce a stable and translucent beverage having no visible particles of extract. In view of this, it is clear that all the important and critical limitations set forth in the presently claimed invention are not found in the '918 reference. Thus, the obviousness rejection must be withdrawn and rendered moot.

IV. Rejection Under 35 USC §103

The Examiner has rejected claims 1-9 under 35 USC §103 as being unpatentable over Schellgell et al., U.S. Patent No. 3,641,918 (hereinafter '918) as applied above and further in view of Hynes, U.S. Patent No. 4,550,651 (hereinafter '651). In the rejection, the Examiner mentions,

in summary, that if it is shown that the use of a beverage brewing machine in the instant claims affects the process in the manipulative sense, it should be noted that it is well known to provide a coffee brewing device that includes a holding and cooling tank. As such, the Examiner believes that all pending claims are obvious.

Notwithstanding the Examiner's apparent position to the contrary, it is the Applicant's position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

As already made of record, the present invention is directed to a method for making a beverage wherein a beverage extract is heated within a beverage brewing machine to a temperature from about 75°C to about 90°C to produce a heated beverage extract whereby the heated beverage extract is mixed with a solvent to produce a beverage on demand. The invention is further defined by the dependent claims which claim, among other things, that the beverage extract is a tea extract, that the solvent is water and heated to a temperature from about 40°C to about 100°C, the weight percent of heated solvent employed, the weight percent of extract employed and the fact that the resulting beverage is translucent and not containing visible particles of extract.

In contrast, and as already made of record, the '918 reference is merely directed to an automatic coffee dispenser wherein concentrate of coffee is heated to a significantly lower temperature than the beverage extract of the present invention. The '651 reference, on the otherhand, is merely directed to a batch-brewing coffee system that cures none of the deficiencies of the '918 reference. The '651 reference merely discloses a system where brewed coffee is stored at a reduced temperature until it is needed, preventing deterioration of flavor.

Since all of the important and critical limitations set forth in the presently claimed invention are not found in the combination of references relied on by the Examiner, the rejection made under 35 USC §103 is improper and should be withdrawn.

Applicants submit that all pending claims of record are now ready to pass to issue. Also, the claims of record are now ready for appeal.

In the event the Examiner has any questions concerning the present patent application, he is kindly invited to contact the undersigned at his earliest convenience.

Respectfully submitted,

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